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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/747,694	12/30/2003	Barry Appelman	06975-398001 / Communicat	2854
26171 7590 07/08/2008 FISH & RICHARDSON P.C. P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER OSMAN, RAMY M	
			ART UNIT 2157	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/747,694	Applicant(s) APPELMAN ET AL.	
	Examiner RAMY M. OSMAN	Art Unit 2157	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 16 and 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 18-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 December 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/10/04, 3/24/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. This action is responsive to amendment filed on April 22, 2008, where Applicant withdrew claims 16-17. Claims 1-15 and 18-27 remain pending.

Election/Restrictions

2. Applicant's election without traverse of Group I (i.e. claims 1-15 and 18-27) in the reply filed on 4/22/2008 is acknowledged.

Claim Rejections - 35 USC § 101

3. Claim 60 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claim recites "means for" limitations. Applicants specification mentions that the invention can be a software-only implementation. Therefore, the scope of the "means for" limitation encompasses a software-only embodiment. Software is not statutory because it is simply abstract ideas and is not directed to a process occurring as a result of executing the software on an actual physical device. For a claim like this to be statutory, an actual hardware device is required to limit the scope. These claims do meet this criterion and are therefore deemed non-statutory. **See MPEP Chapter 2106.01 Section I.**

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 2157

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-24 and 36-63 rejected under 35 U.S.C. 102(e) as being anticipated by

Isaacs et al (US Patent No 6,760,754).

6. In reference to claim 1, Isaacs teaches a method for audibly informing a recipient of an arrival of a digital communication from a sender, the method comprising:

receiving a digital communication from a sender directed to a recipient; determining whether the digital communication is associated with an audio identifier that identifies the sender of the digital communication and that is designated by the sender of the digital communication; (column 7 lines 40-51) and

conditioning perception by the recipient of the audio identifier on whether the digital communication is determined to be associated with the audio identifier, the audio identifier being perceived prior to or concurrent with perception of the digital communication by the recipient. (column 7 line 52 – column 8 line 5)

7. In reference to claim 2, Isaacs teaches the method of claim 1, wherein the digital communication is an instant message. (column 1 lines 14-22)

8. In reference to claim 3, Isaacs teaches the method of claim 1, wherein the digital communication is an e-mail. (column 1 lines 14-22)

9. In reference to claim 5, Isaacs teaches the method of claim 1, wherein the audio identifier is a spoken version of a user identifier of the sender. (column 3 lines 5-18)

10. In reference to claim 6, Isaacs teaches the method of claim 1, wherein determining whether the digital communication is associated with an audio identifier comprises determining whether an audio identifier has been received from the sender. (column 7 lines 45-51)

11. In reference to claim 7, Isaacs teaches the method of claim 6, wherein determining whether an audio identifier has been received from the sender includes determining whether the audio identifier has been received with the digital communication. (column 7 lines 45-51)

12. In reference to claim 8, Isaacs teaches the method of claim 1, wherein determining whether the digital communication is associated with an audio identifier comprises accessing a data store based on a user identifier of the sender. (column 7 line 52 – column 8 line 5)

13. In reference to claim 9, Isaacs teaches the method of claim 8, wherein the user identifier of the sender is included in the digital communication. (column 4 line 66 – column 5 line 9)

14. In reference to claim 10, Isaacs teaches the method of claim 8, wherein the user identifier is an e-mail address, an instant messaging handle, or a screen name. (column 4 line 66 – column 5 line 9)

15. In reference to claim 11, Isaacs teaches the method of claim 1, wherein recipient perception of the audio identifier also is conditioned on whether communication exchange preferences associated with the recipient allow the recipient to perceive the audio identifier. (column 6 lines 25-37)

16. In reference to claim 12, Isaacs teaches the method of claim 11, wherein the recipient is allowed to perceive the audio identifier when the communication exchange preferences explicitly include a setting indicating that the recipient is allowed to perceive the audio identifier. (column 6 lines 25-37)

17. In reference to claim 13, Isaacs teaches the method of claim 12, wherein the setting is set by the recipient in response to a query. (column 6 lines 25-37 and column 7 lines 40-45)

18. In reference to claim 14, Isaacs teaches the method of claim 11, wherein the recipient is not allowed to perceive the audio identifier when the communication exchange preferences explicitly include a setting indicating that the recipient is not allowed to perceive the audio identifier. (column 7 line 60 – column 8 line 5)

19. In reference to claim 15, Isaacs teaches the method of claim 14, wherein the setting is set by the recipient in response to a query. (column 6 lines 25-37 and column 7 lines 40-45)

20. In reference to claim 16, Isaacs teaches the method of claim 11, wherein the recipient is not allowed to perceive the audio identifier or the digital communication when the communication exchange preferences explicitly include a setting indicating that the recipient is not allowed to perceive the audio identifier or the digital communication. (column 7 lines 40-45)

21. In reference to claim 17, Isaacs teaches the method of claim 16, wherein the setting is set by the recipient in response to a query. (column 6 lines 25-37 and column 7 lines 40-45)

22. In reference to claim 18, Isaacs teaches the method of claim 1, further comprising enabling the recipient to perceive a user interface and allowing the recipient to perceive the audio identifier if the recipient selects a user interface element that corresponds to authorization of the audio identifier. (column 6 lines 45-67)

23. In reference to claim 19, Isaacs teaches the method of claim 1, wherein recipient perception of the audio identifier also is conditioned on whether the recipient is available to receive the digital communication. (column 6 lines 45-67)

24. In reference to claim 20, Isaacs teaches the method of claim 19, further comprising discarding the digital communication if the recipient is not available to receive the digital communication. (column 5 lines 10-34)

25. In reference to claim 21, Isaacs teaches the method of claim 19, further comprising depositing the digital communication in a data store for later retrieval by the recipient conditioned on whether the recipient is not available to receive the digital communication. (column 5 lines 10-34)

26. In reference to claim 22, Isaacs teaches the method of claim 1, further comprising enabling the recipient to perceive a sender profile. (column 5 lines 10-34)

27. In reference to claim 23, Isaacs teaches the method of claim 1, wherein the sender comprises a caller and the digital communication comprises a phone call and wherein: receiving a digital communication comprises receiving the phone call directed to the recipient; determining whether the digital communication is associated with an audio identifier comprises determining whether the phone call is associated with an audio identifier that identifies the caller and that is designated by the caller; and conditioning perception of the audio identifier comprises conditioning perception of the audio identifier on whether the phone call is determined to be associated with the audio identifier, the audio identifier being perceived as a ring tone for the phone call. (column 7 line 40 – column 8 line 5)

28. In reference to claim 24, Isaacs teaches the method of claim 23, wherein enabling the recipient to perceive the audio identifier comprises playing the audio identifier multiple times in repetition to serve as a ring tone for the phone call. (column 1 lines 15-35)

Claim Rejections - 35 USC § 103

29. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

30. **Claims 4 and 39 rejected under 35 U.S.C. 103(a) as being unpatentable over Isaacs et al (US Patent No 6,760,754).**

31. In reference to claim 4, Isaacs teaches the method of claim 1. Although Isaacs fails to explicitly teach wherein the digital communication is a voice mail, utilizing voicemail is an obvious variation of other types of conventional communication methods such as email, IM and video conference messaging.

32. In reference to claims 36-63, these are claims that correspond to the method claims of claims 1-24 above, and are just minor variations thereof. Therefore, claims 36-63 are rejected based upon the same rationale as given for claims 1-24 above.

Conclusion

33. The above rejections are based upon the broadest reasonable interpretation of the claims. Applicant is advised that the specified citations of the relied upon prior art, in the above rejections, are only representative of the teachings of the prior art, and that any other supportive sections within the entirety of the reference (including any figures, incorporation by references, claims and/or priority documents) is implied as being applied to teach the scope of the claims.

34. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See attached Form 892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RAMY M. OSMAN whose telephone number is (571)272-4008. The examiner can normally be reached on M-F 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ramy M Osman/
Primary Examiner, Art Unit 2157

July 7, 2008